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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,128	05/10/2001	Thomas Boussie	99-111CIP1	7420

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EXAMINER
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EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/15/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

File Copy

Application No.

09/854,128

Applicant(s)

BOUSSIE ET AL.

Examiner

Jon D Epperson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

**Please note:** The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1639**.

#### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24, drawn to a method for “making and screening a polymer array”, classified variously in class 436, subclass 501+ and 435, subclass 6+.
  - II. Claims 25-33, drawn to a polymer array, classified in class 525, subclass 50+ and in various other classes/subclasses depending on the nature of the “polymer”.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case both the process of making polymer libraries and the process of using (e.g., polymer “characterization”) the resulting product (e.g., polymer array) as claimed can be practiced with another materially different method of making and screening polymer libraries e.g., either the making and use of polymer libraries in a non-array format: e.g., solution phase or by solid phase syntheses (separately) to make polymers for screening (e.g., see

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specification pages 1-2 illustrating convention solution/solid phase method for screening polymers). Additionally, the polymer as claimed (e.g., the polymer array) can be used in a materially different process of using that product as in additives of potential therapeutic agents (e.g., see Weinberg et al U.S. Pat. No. 6,030,917 (abstract) submitted in the IDS).

4. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different methods and products would require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

#### *Species Election*

5. This application contains claims directed to patentably distinct species of the claimed invention for Groups I-IV. Election is required as follows.

6. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species. Claim 1 is generic.

##### Subgroup 1: Species of substrate (see claim 1)

Applicant must elect, for the purposes of search, a **single species** of substrate (e.g., glass, quartz, see specification page 8).

##### Subgroup 2: Species of wettable material (see claims 1,2,12)

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Applicant must elect, for the purposes of search, a single species of wettable material (e.g., Au, Cr, etc. see specification, page 7, line 21). Applicant must further indicate if the material is “unsilanizable” or not? Please note that Applicant must elect “one” wettable material wherein all atoms and bonds are shown (i.e., using notations like R, X, etc. that could represent more than one compound would be an improper election).

Subgroup 3: Species of non-wettable material (see claim 1)

Applicant must elect, for the purposes of search, a single species of non-wettable material (e.g., methyltrichlorosilane, phenyltrichlorosilane, etc., see specification page 9, lines 14-15). Applicant must further indicate if the material is a “organosilane agent”? Please note that Applicant must elect “one” non-wettable material wherein all atoms and bonds are shown (i.e., using notations like R, X, etc. that could represent more than one compound would be an improper election).

Subgroup 4: Species of polymeric materials (see claim 1)

Applicant must elect, for the purposes of search, a single species of polymeric materials (e.g., olefins, saccharides, see specification, pages 16-19,22). Please elect a “representative” example.

Subgroup 5: Species of characterization technique (see claims 1,11)

Applicant must elect, for the purposes of search, a single species of characterization technique (e.g., UV-Visible spectroscopy, see specification, page 22, last paragraph).

Subgroup 6: Species of deposition (see claims 1,3-4)

Applicant must elect, for the purposes of search a single species of deposition (e.g., “overlaying a template comprising holes” in conjunction with “vapor deposition”, see claim 3-4).

7. If applicant elects the invention of Group II, applicant is required to elect from the following patentably distinct species. Claim 25 is generic.

Subgroup 1: Species of substrate (see claim 25)

Applicant must elect, for the purposes of search, a single species of substrate (e.g., glass, quartz, see specification page 8).

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Subgroup 2: Species of wettable material (see claim 25)

Applicant must elect, for the purposes of search, a single species of wettable material (e.g., Au, Cr, etc. see specification, page 7, line 21). Applicant must further indicate if the material is “unsilanizable” or not? Please note that Applicant must elect “one” wettable material wherein all atoms and bonds are shown (i.e., using notations like R, X, etc. that could represent more than one compound would be an improper election).

Subgroup 3: Species of non-wettable material (see claim 25)

Applicant must elect, for the purposes of search, a single species of non-wettable material (e.g., methyltrichlorosilane, phenyltrichlorosilane, etc., see specification page 9, lines 14-15). Applicant must further indicate if the material is a “organosilane agent”? Please note that Applicant must elect “one” non-wettable material wherein all atoms and bonds are shown (i.e., using notations like R, X, etc. that could represent more than one compound would be an improper election).

Subgroup 4: Species of polymeric materials (see claim 25)

Applicant must elect, for the purposes of search, a single species of polymeric materials (e.g., olefins, saccharides, see specification, pages 16-19,22). Please elect a “representative” example.

Subgroup 5: Species of contact angle (see claim 29)

Applicant must elect, for the purposes of search, a single species of contact angle (e.g., 90°).

8. **Please Note:** Applicants must disclose which claims read on the elected species (see paragraphs 12 and 13 below).
9. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. For different species of method, the method steps for each species would differ. Moreover, the above species can be separately classified. Consequently, the species have different issues regarding patentability and represent patentably distinct subject matter.

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Therefore, this does create an undue search burden, and election for examination purposes as indicated is proper.

10. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

11. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

13. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, *applicant must indicate which are readable upon the elected species*. MPEP § 809.02(a).

14. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

15. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

16. Applicant is also reminded that a 1 – month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an “action on the merits” for purposes of the second action final program, see MPEP 809.02(a).

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday through Friday from 8:30 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.  
August 12, 2003

BENNETT CELSA  
PRIMARY EXAMINER

  
